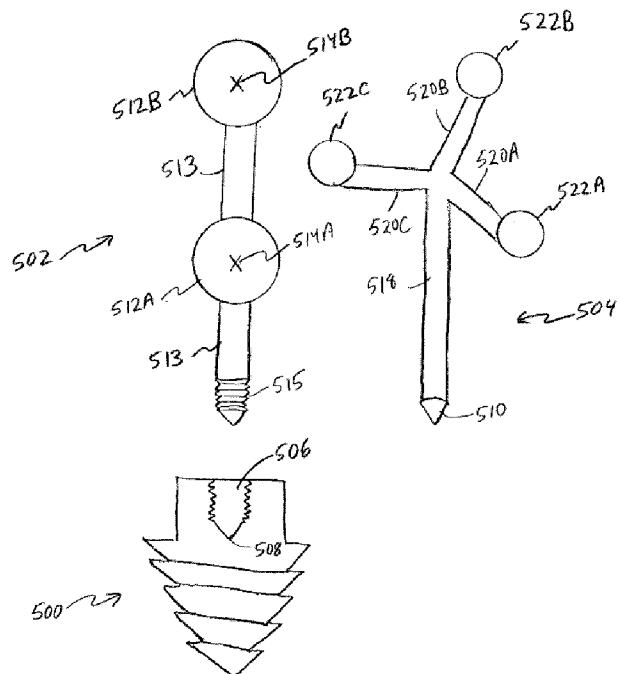


REMARKS

The remarks herein are responsive to the non-final Office Action dated 14 May 2009. Claims 11 and 34 have been amended. Claims 1-10, 12, and 18-26 have been cancelled. Claims 41-45 have been added. Thus, claims 11, 13-17, and 27-41 are pending. Applicant thanks the examiner for his time during the interview of 6 August 2009.

Rejection of the Claims under 35 U.S.C. § 102

Claims 11, 13-15, 17, 34, 36, 37, and 40 stand rejected under 35 U.S.C. § 102 as anticipated by Lee (U.S. Publication No. 2004/00302037). Lee discloses fiducial marker devices and methods. Lee discloses a system with three primary elements, described here in relation to Figure 5 (below). Lee describes a base 500 screwed into a patient. A locator 502 can then be screwed into the base and images of the patient can be taken. The locator 502 can then be removed and the patient can be transported to the operating room. The location of the bases 500 can then be determined by inserting the wand 504.



Claim 11

Amended Claim 11 recites, *inter alia*, “a body with at least one but fewer than three target markers, the target markers configured to communicate a signal to a recording device of a navigation system; and an engagement portion attached to the body, the engagement portion and the body being a single piece, the engagement portion configured for engagement with a bone of a

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mammal and comprising a self-drilling, self-tapping thread.” Applicant respectfully submits that not all of these limitations are disclosed, taught, or suggested by Lee.

For example, amended Claim 11 recites that the engagement portion and the body are a single piece. Applicant respectfully submits that the portion of Lee that engages with the bone of the patient is distinct from any portion that may include target markers. As another example, Applicant respectfully submits that Lee does not disclose a body with a self-drilling, self-tapping thread, as claimed. For example, the tip of the locator 502 lacks threading, preventing any initial tapping. Further, the locator 502 is configured to enter a pre-tapped receptacle 506 (as depicted in Figure 5 and described in a similar embodiment at [0023]). Applicant additionally notes that the base 500 of Lee is separate from any body that may include target markers.

Further, Applicant respectfully submits that Lee generally would teach away from a locator as described in Claim 11. Lee is designed to allow the locators 502 to be removed after initial imaging by using only a small base 500 for attachment to the bone. This mechanism is contrary in both purpose and function to pending Claim 11.

Accordingly, Applicant respectfully submits that Lee does not teach all of the features of amended Claim 11, so that amended Claim 11 is allowable over Lee. Claims 13-15 and 17 depend from amended Claim 11 and are therefore likewise allowable over Lee, not only because they depend from an allowable base claim, but also because each of these claims recites a unique combination of features, not taught or suggested by the cited art.

Claim 34

Amended 34 recites, *inter alia*, “an L-shaped body with two reflector or transmitter elements extending along a pivot axis of the body and configured to communicate a signal to an optical recording device; and an engagement portion attached to the body, the engagement portion configured for engagement with a bone of a mammal.” Applicant respectfully submits that not all of these limitations are disclosed, taught, or suggested by Lee. For example, amended Claim 34 recites an L-shaped body. Applicant respectfully submits that this is not disclosed by Lee.

Accordingly, Applicant respectfully submits that Lee does not teach all of the features of amended Claim 34, so that amended Claim 34 is allowable over Lee. Claims 36, 37, and 40 depend from amended Claim 34 and are therefore likewise allowable over Lee, not only because

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they depend from an allowable base claim, but also because each of these claims recites a unique combination of features, not taught or suggested by the cited art.

Additionally, Claims 16, 35, and 39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lee. Applicant respectfully submits that these claims are also allowable over Lee, not only because they depend from an allowable base claim, but also because each of these claims recites a unique combination of features, not taught or suggested by the cited art.

Rejection of the Claims Under 35 U.S.C. § 103

Claims 27-33 and 38 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lee in view of Sarin (US Pub. No. 2003/0153829). Sarin discloses a non-imaging, computer assisted navigation system for hip replacement surgery. Notably, Sarin makes “[n]ote that [its] method does not require the patient to remain immobile between defining the pelvic plane... and navigation..., because any motion of the pelvis is tracked by the fixed pelvic tracking marker.”

However, as discussed above, the markers in Lee are removed during operation, and thus the patient must remain immobile (contrary to Sarin). In Lee, the patient is imaged with the locators 502 attached, but afterward is only measured using the wand 504, after which the patient must remain motionless. If the patient were moved, the patient would have to be measured again. Thus, Lee and Sarin are directed to different problems and teach away from each other. It would not be obvious to one of skilled in the art to combine these references for at least these reasons.

Further, Applicant respectfully submits that Lee and Sarin do not disclose all the elements of Claims 27-33 and 38. For example, Claim 20 recites that “the two markers extend along a pivot axis of the body.” Applicant respectfully submits that this limitation is not satisfied by the Figures in Sarin. For example, regarding Claim 29 the markers 56 depicted in Figure 3 are not aligned with any pivot axis of the probe 50, but instead extend along an axis at an angle to the stem 53 (which appears to be aligned with the only possible pivot axis).

For at least the reasons set forth above, Applicant respectfully submits that Claims 27-33 and 38 are allowable over Lee and Sarin.

New Claims

Applicant has added new Claims 41-45. Applicant respectfully submits that new Claims 41-45 are allowable over the references cited. No new matter has been added.

No Disclaimers or Disavowals

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Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Co-Pending Applications of Assignee

Applicant wishes to draw the Examiner's attention to the following co-pending applications of the present application's assignee.

| Docket No. | Serial No. | Title | Filed |
|-------------------|-------------------|---|--------------|
| MEISS71.002C1 | 11/205,761 | METHOD AND APPARATUS FOR FINDING THE POSITION OF A MECHANICAL AXIS OF A LIMB | 8/16/2005 |
| MEISS71.021C1 | 10/994,186 | ARRANGEMENT FOR ASCERTAINING FUNCTION-DETERMINING GEOMETRIC PARAMETERS OF A JOINT OF A VERTEBRATE | 11/19/04 |

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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Dated: September 14, 2009

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